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| 10/535,762 | 07/22/2005 | Karin Schutze | K&W/12681US | 9270 |
| 27316 7590 11/27/2009 MAYBACK & HOFFMAN, P.A. 5722 S. FLAMINGO ROAD #232 FORT LAUDERDALE, FL 33330 | | | | |
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| FRITCHMAN, REBECCA M | | | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/535,762

Applicant(s)

SCHUTZE ET AL.

Examiner

REBECCA FRITCHMAN

Art Unit

1797

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 July 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/CD)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

***Detailed Action
Summary***

1. This is the Final Office action based on the 10/535762 application attorney remarks filed on 07/13/2009.
2. Claims 1-20 are pending and have been fully considered.

Claim Rejections - 35 USC § 103

3. **Claims 1-20 are rejected under 35 U.S.C. 103(a) as being obvious over GANSER in US 6787301 in view of NORRIS in US 5592289.**

With respect to Claims 1, 19, & 20 GANSER et al. teach of a method for laser microdissection which allows a specimen field to be cut out from a specimen in a reliable and convenient fashion. Specifically, with respect to Claim 1, GANSER et al. teach of a laser microdissection device with a microscope for observing biological material on a specimen holder (column 2, lines 31-49), (column 1, lines 15-20). GANSER et al also teach of a holder (**receptacle container= glass slide which the biological specimen is put on, & holder = x-y- stage**) which is provided for receiving the biological object which is excised from the biological material(**the holder is capable of holding a receptacle device having a plurality of containers**) (column 2, lines 57-67 & column 3, line 1-11). GANSER et al. does not teach of identifying receptacles by evaluating coding or of multiple receptacle containers. NORRIS however does teach of identifying receptacles by evaluating coding and of multiple receptacle containers with different well configurations (column 8, lines 7-11). NORRIS also teaches of controlling

the position of the receptacle device to allow for analysis and preparation of samples (column 2, paragraph 3) (abstract). It would be obvious to combine the laser microdissection apparatus of GANSER with the identification mechanism of NORRIS to provide for sample or container specific analysis and specimen specific holding due to the desire for a receptacle positioning mechanism, to accommodate analyte receptacles of various configurations and to supply this information to the computer and (Column 3, paragraph 2) due to the need for a device which can properly align receptacles(column 1, paragraphs 2 & 3, column 2, paragraph 4).

Alternatively, NORRIS teaches of identifying receptacles by evaluating the coding on multiple receptacle containers with different well configurations (column 8, lines 7-11). NORRIS also teaches of controlling the position of the receptacle device to allow for analysis and preparation of samples (column 2, paragraph 3) (abstract). NORRIS does not teach of they system being used for laser microdissection. GANSER et al., however does teach of a laser microdissection system(column 2, lines 31-49), (column 1, lines 15-20). It would be obvious to combine the mechanism for aligning and identifying receptacles of NORRIS with the laser microdissection system of GANSER to allow for more complete and accurate dissection and identification due to the current problems in the art of cutting specimens (column 1, lines 21-29).

With respect to Claim 2, NORRIS teaches of the optical scanning of the analyte receptacle (column 5, lines7-10).

With respect to Claims 3 & 4, NORRIS teaches of the optical scanning of the analyte receptacle (column 5, lines7-10). NORRIS discloses the claimed invention

except for the use of inductive or capacitive scanning of the coding. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a capacitive or inductive code as opposed to an optical code since the examiner takes official notice of the equivalence of optical to capacitive or inductive codes for their use in identifying objects and the selections of any of these known equivalents to code and object would be obvious to one of ordinary skill in the art.

With respect to Claim 5, GANSER et al. teach of monitoring the camera image (column 6, lines 58-65). GANSER et al. does not teach of specifically monitoring the image of the receptacle device. NORRIS teaches of repeatable positioning of the analyte receptacle being important for analysis of the image (column 1, lines 25-31). From this, it would be obvious to monitor the position of the receptacle device by image analysis.

With respect to Claim 6, NORRIS et al. teach of positioning the receptacle devices (abstract).

With respect to Claim 7, NORRIS teaches of positioning the receptacle device with respect to the microscope (column 1, lines 23-30).

With respect to Claim 8, GANSER et al. teach of monitoring the camera image (column 6, lines 58-65). GANSER et al. does not teach of specifically monitoring the image of the receptacle device. NORRIS teaches of repeatable positioning of the analyte receptacle being important for analysis of the image (column 1, lines 25-31). From this, it would be obvious to monitor the position of the receptacle device by image analysis.

With respect to Claim 9, GANSER et al. teach of acquiring an image of the specimen which is going to be dissected (column 5, lines 11-21).

With respect to Claim 10, GANSER et al. teach of a laser microdissection device with a microscope for observing biological material on a specimen holder (column 2, lines 31-49), (column 1, lines 15-20). GANSER et al also teach of a holder (receptacle device) which is provided for receiving the biological object which is excised from the biological material (column 2, lines 57-67 & column 3, line 1-11) specifically being an X-Y stage (holder) which has a glass specimen slide (plate) (column 2, lines 57-67, & column 3, lines 1-11) which allows for control of the dissection protocol for a dissection work sequence which can be carried out with respect to the receptacle device.

With respect to Claim 11, GANSER et al. teach of a specimen holder and a stage (frame) (column 3, lines 7-11).

With respect to Claim 12, GANSER et al. teach of a laser which generates a laser beam having at least one optical system that couples the laser beam into the objective(column 2, lines 36-49) (optical scanning), and of a specimen holder(column 2, lines 57-67) . GANSER et al. does not teach of the receptacle device having an optical code. NORRIS et al., however does theca of the receptacle device having and optical code (column 5, lines7-10).

With respect to Claim 13, NORRIS et al. teach of the coding being a binary code which is defined by through openings (column 7, lines 19-22).

With respect to Claim 14, NORRIS teaches of the code being a barcode (column 9, lines 1-10).

With respect to Claims 15-17, NORRIS teaches of the optical scanning of the analyte receptacle (column 5, lines 7-10). GANSER and NORRIS disclose the claimed invention except for the use of inductive or capacitive code in the form of a transponder. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a capacitive or inductive code as opposed to an optical code since the examiner takes official notice of the equivalence of optical to capacitive or inductive codes for their use in identifying objects and the selections of any of these known equivalents to code and object would be obvious to one of ordinary skill in the art.

With respect to Claim 18, NORRIS et al. teach of a holder which is designed to hold a receptacle device (microplates) (column 1, lines 31-41 & claim 18). It is obvious if a device can hold plates of varying sizes that it can also hold caps and tubes.

Response to Arguments

Applicant's arguments filed 07/13/2009 have been fully considered but they are not persuasive.

GANSER et al. teach of a laser microdissection device with a microscope for observing biological material on a specimen holder (column 2, lines 31-49), (column 1, lines 15-20). GANSER et al also teach of a holder which is provided for receiving the biological object which is excised from the biological material (**receptacle container = glass slide which the biological specimen is put on, & holder = x-y- stage**) holder is designed to (**the holder is capable of holding a receptacle device having a plurality of containers**) (column 2, lines 57-67 & column 3, line 1-11). GANSER et al.

does not teach of identifying receptacles by evaluating coding or of multiple receptacle containers. NORRIS however does teach of identifying receptacles by evaluating coding and of multiple receptacle containers with different well configurations (column 8, lines 7-11). NORRIS also teaches of controlling the position of the receptacle device to allow for analysis and preparation of samples (column 2, paragraph 3) (abstract). It would be obvious to combine the laser microdissection apparatus of GANSER with the identification mechanism of NORRIS to provide for sample or container specific analysis and specimen specific holding due to the desire for the receptacle positioning mechanism, to accommodate analyte receptacles of various configurations and to supply this information to the computer (Column 3, paragraph 2) due to the need for a device which can properly align receptacles(column 1, paragraphs 2 & 3, column 2, paragraph 4).

Applicant claims a "holder which can hold a receptacle device having a plurality of containers". This means that the holder must only be capable of holding a receptacle device having a plurality of containers. Applicant does not currently claims the actual receptacle device which has a plurality of containers." Therefore, the rejection is maintained.

Also, applicant claims that the control means is "capable of being displayed to a user" the control means in NORRIS is capable of this function. NORRIS also provides selection functions which are specific to the receptacle device column 2, paragraph 3) (abstract).

Also, it would be obvious to combine the laser microdissection apparatus of GANSER with the identification mechanism of NORRIS to provide for sample or container specific analysis and specimen specific holding due to the desire for the receptacle positioning mechanism, to accommodate analyte receptacles of various configurations and to supply this information to the computer (Column 3, paragraph 2) due to the need for a device which can properly align receptacles(column 1, paragraphs 2 & 3, column 2, paragraph 4). The receptacle device in NORRIS is identified with a code. NORRIS is relied upon to teach this feature. Both Ganser and Norris relate to sample preparation which inherently ends with sample analysis.

Conclusion

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to REBECCA FRITCHMAN whose telephone number is (571)270-5542. The examiner can normally be reached on Monday- Friday 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vickie, Kim can be reached on 571-272-0579. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Krishnan S Menon/

Primary Examiner, Art Unit 1797

RF